

Remarks

Claims 1 to 21 were in the application as filed. Claims 1 to 21 were cancelled and Claims 22 to 33 were added in the Preliminary Amendment filed on September 10, 2003. Claim 30 was cancelled and claims 34 to 36 were added in the Amendment filed on June 26, 2007.

Claim 23 has been cancelled as being essentially redundant over claim 22.

Claims 25, 26, 34 and 36 have been amended to indicate that only one compound is required for the method of treatment.

Claims 34 and 36 have been amended to change their dependencies from claim 26 to claim 25.

Claim 34 has been amended to recite the types of anticancer agents that may be administered in combination with a compound of claim 22. Claim 35 has been amended to recite particular anticancer agents that may be administered in combination with a compound of claim 22. Support for these amendments may be found, for example, in the specification on page 24, line 18 to page 26, line 2.

Claims 28 and 29 have been cancelled.

Applicants reserve the right to prosecute the deleted subject matter in one or more continuation, continuation-in-part or divisional applications.

No new matter has been added by these amendments.

As presently amended, claims 22, 24 to 27, and 31 to 36 are pending in this application.

Discussion of Allowed Claims

Applicants acknowledge, with appreciation, the Examiner's allowance of claims 22 to 24, and 27.

Discussion of Rejections under 35 USC § 112, First Paragraph

The Examiner has maintained the rejection of claim 26 and has newly rejected claims 28 to 29, and 31 and 36 under 35 U.S.C. § 112, first paragraph, on the grounds that the specification, while being enabling for the inhibition of telomerase, fluorescence of the g-quartet,

and inhibition for the A549 cell line, is allegedly non-enabling for the treatment of all forms of cancers. Claims 28 to 29, 32 to 33, and 35 to 36 are further rejected for being non-enabled for the compositions of said claims.

This rejection is traversed, and reconsideration is respectfully requested for the reasons given hereinbelow.

The Examiner acknowledges that the specification is enabling for methods of inhibiting telomerase. Applicants have therefore amended claims 34 and 36 to change their dependency from claim 26 to claim 25, which is directed to a method of inhibiting telomerase activity. Accordingly, the rejection of claims 34 and 36 is believed overcome.

As to claim 26, the specification describes the procedures for evaluating the cytotoxic activity on human tumor cell lines (specification, pages 32 to 34), and provides the results against a human lung cancer cell line, A549, in Example 17. It is respectfully submitted that one skilled in the art would consider claim 26 fully enabled for the treatment of lung cancer, especially in view of the telomerase activity of the compounds of the invention. In view of the present amendment to claim 26, now particularly claiming a method of treating lung cancer, the 35 U.S.C. § 112, first paragraph rejection of claim 26 is believed overcome.

As an apparently different basis for rejection, the Examiner states that “[r]egarding compositions of claims 28-29, 32-33, and 35-36, applicants have not shown any attempt to actually produce compositions comprising compounds of claim 22 and other anticancer agents... Without any proof that these compositions are stable, applicants are not enabled for compositions” (Office Action, pages 4 to 5, emphasis added).

Other than claims 28 and 29, the claims mentioned by the Examiner are method of treatment claims, and not composition claims. Therefore, the present rejection of the method of treatment claims 32 to 33 and 35 to 36 is believed unwarranted.

With respect to claims 28 and 29, the Examiner’s enablement rejection is rendered moot in view of the cancellation of said claims.

The Examiner further states that “[f]or claim 36, applicants do not show that the compositions of claim 26, in conjunction with tumor radiation will result in more effective cancer treatment. It is well known in the art that chemotherapy involves radiation of the tumor”

(Office Action, page 5). However, this statement is completely irrelevant with respect to a rejection based on lack of enablement. Nothing in 35 U.S.C. § 112, first paragraph requires a claimed treatment be better than a previous treatment. In fact, the Examiner's statement that it is well known in the art to involve radiation with a cancer chemotherapy actually supports the objective enablement of claim 36.

For the reasons given hereinabove, Applicants respectfully request the withdrawal of the rejection of Claims c6, 28 to 29, and 31 and 36 under 35 U.S.C. § 112, first paragraph.

Rejections under 35 USC § 112, First Paragraph

Claims 25, 26, 28, and 34 are newly rejected under 35 U.S.C. § 112, second paragraph, as being, the Examiner alleges, indefinite for the use of the phrase "one or more" in conjunction with the number of compounds being administered. The Examiner states that "[t]his phrase is **broad** in nature because it leaves the number of compounds being administered to the patient **open**....Applicants never show examples in the specification where two or more compounds of claim 22 are being used to bond g-quartets" (Office Action, page 6, emphasis added).

MPEP 2173.02 provides that "[i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope." Because open-ended phrases such as "one or more" would be understood by one of ordinary skill in the art, such phrases would not render a claim indefinite. In fact, the transitional phrase "comprising" is open-ended, yet such phrase is readily understood and accepted for use in United States patent claims. Furthermore, the Examiner alludes to the fact the "one or more" phrase is broad. However, **breadth is not indefiniteness** (see e.g. MPEP 2173.04).

The Examiner concludes that Applicants never show examples of two or more compounds of claim 22 being used. Even if this is true, it is completely irrelevant to the question of definiteness.

Nevertheless, Applicants have amended claims 25, 26, 28, and 34 to delete the phrase "one or more" for the sole reason of advancing prosecution of this application. Accordingly, withdrawal of the Examiner's rejection of claims 25, 26, 28, and 34 is respectfully requested.

Claims 28 and 34 are also newly rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for the use of the words "derivatives" and "analogues". Although such terms would be readily understood by those of skill in the art, Applicants have cancelled claim 28 and have amended claim 34 to list specific "derivatives" and "analogues". Accordingly, withdrawal of this rejection is respectfully requested.

There being no remaining issues, this application is believed in condition for favorable reconsideration and early allowance, and such actions are earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

September 14, 2007

Date

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Sanofi-Aventis Docket No. ST99049G1 US DIV